

### REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 20, 22-25, and 27-31 are pending in this application, Claims 1-19 and 21 having been cancelled without prejudice or disclaimer, Claims 29-31 having been added, and Claims 20, 22, 23, and 27 having been amended. Support for amended and new Claims 23, 27, and 29-31 can be found, for example, in the original claims, drawings, and in the specification as originally filed.<sup>1</sup> Applicants respectfully submit no new matter is added.

In the outstanding Office Action, Claims 20-25 and 27-28 were rejected under 35 U.S.C. § 102(e) as anticipated by Van Valer (U.S. Patent No. 6,714,209).

In response to the rejection under 35 U.S.C. § 102(e), Applicants respectfully submit that amended independent Claim 23 recites novel features clearly not taught or rendered obvious by the applied references.

Amended independent Claim 23 is directed to a system for performing processes used for generating printing data including, *inter alia*;

... a network capable client configured to locally control/perform said processes used for generating printing data on the basis of which a disk label is creatable; and

a network capable server configured to offer functionality directly usable and installable on said network capable client, wherein said functionality is adapted to locally control/perform said processes used for generating printing data on the basis of which said disk label is creatable, wherein said network capable client and said network capable server are connected with each other via a communication network, wherein said printing data are generated based on graphic data representing said disk label, wherein, in advance of finalizing said graphic data for said disk label, a disk label printing area is determined in dependence on a disk category and a disk type selected by a user, and wherein, during the process of generating said graphic data all instructions recognized as

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<sup>1</sup> See page 8, line 30 to page 13, line 11 of the specification; page 7, lines 19-32, original Claims 20 and 21; and Figure 2.

leading to the generation of printing data which cannot be assigned to the determined disk label printing area are blocked.

Van Valer describes a browser-based system that provides a methodology for labeling compact discs storing photos with a photo-facsimile table of contents. However, Van Valer fails to teach or suggest “a network capable server configured to offer functionality directly usable *and installable on said network capable client*” and a “network capable client configured to *locally control/perform* said processes used for generating printing data on the basis of which a disk label is creatable,” as recited in Applicants’ amended independent Claim 23.

Van Valer does not describe that the network capable client is adapted to locally perform processes used for generating printing data. Further, the server of Van Valer does not offer functionality installable on the network capable client. In Van Valer, printing data are generated at the *server* side and not locally by the client. Consequently, Van Valer does not show that the server offers functionality to be installed on the network capable client.

An advantage of the client locally performing the processes used for generating printing data is that the server uses less processing power. Further, network traffic may be reduced since the client does not need to repeatedly access the server via the communication network if the server performs the needed processes for generating printing data.

Further, Van Valer does not teach or suggest “in advance of finalizing said graphic data for said disk label, a disk label printing area is determined in dependence on *a disk category and a disk type selected by a user*, and wherein, during the process of generating said graphic data all instructions recognized as leading to the generation of printing data which cannot be assigned to the determined disk label printing area are blocked,” as recited in Applicants’ amended independent Claim 23.

Van Valer describes that a user-definition-to-XML module coordinates with an indexing sizing module to ensure that a user is not attempting to overload the capacity of the printable

surface area on a CD. Van Valer further describes that calculation of the surface area required for each image and/or text label can be determined by computing the dimension of a bounding box that bounds each image and/or text label. In Van Valer, a bounding box for a text label is calculated based on the pre-existing and known dimensions of an image.<sup>2</sup> However, Van Valer does not describe that the printing area is determined in dependence on *a disc category and a disc type selected by a user*. In Applicants' amended independent Claim 23, the system automatically avoids generating unnecessary graphic data that would not fit on the CD/DVD label side of the CD/DVD.

Accordingly, Applicants respectfully submit that amended independent Claim 23 and all claims depending therefrom are patentable.

Amended independent Claim 27 is directed to a method for performing processes used for generating printing data including, *inter alia*:

- ... locally controlling/performing said processes used for generating printing data on the basis of which a disk label is creatable;

- offering functionality directly usable by a network capable client and installable on said network capable client, wherein said functionality is adapted to locally control/perform said processes used for generating printing data on the basis of which a disk label is creatable at said network capable client, wherein said network capable client and said network capable server are connected with each other via a communication network;

- generating, at said network capable client said printing data based on graphic data representing said disk label; and

- determining, at said network capable client and in advance of finalizing said graphic data for said disk label, a disk label printing area in dependence on a disk category and a disk type selected by a user, wherein during the process of generating said graphic data all instructions recognized as leading to the generation of printing data which cannot be assigned to the determined disk label printing area are blocked.

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<sup>2</sup> See Van Valer at column 2, line 66 to column 3, line 28.

Thus, amended independent Claim 27 and all claims depending therefrom are believed to be patentable for at least the reasons discussed above with respect to independent Claim 23.

Accordingly, Applicants respectfully request the rejection of Claims 20-25 and 27-28 under 35 U.S.C. § 102(e), be withdrawn.

Dependent Claim 20 recites “the network capable client is configured to download an applet from the network capable server, and the applet is used in conjunction with a web browser to select the disk category and disk type in order to generate the graphic data for the disk label.” Claim 20 depends on Claim 23 and is believed to be patentable for at least the reasons discussed above. Claim 20 is further believed to be patentable for the reasons described below.

Van Valer does not teach or suggest that the network capable client downloads an applet from the network capable server, and the applet is used in conjunction with a web browser to select the disk category and disk type in order to generate the graphic data for the disk label. Page 3 of the outstanding Official Action asserts that Van Valer’s user-definition-to-XML module 530 teaches the above feature. Van Valer describes a user-definition-to-XML module 530 which runs in a Website’s server system 520 and is an interface for a user to select the digital photos to be stored onto a target CD and to design a table of contents label that will be printed onto the CD.<sup>3</sup> However, Van Valer does not describe that the user-definition-to-XML module is realized as an applet. Also, in Van Valer, XML is not used to select a disk category and disk type in order to generate the graphic data for the disk label. Further, Applicants’ applet can locally control/perform the processes for generating printing data on the basis of which a disk label is creatable.

In order to vary the scope of protection recited in the claims, new Claims 29-31 are added. New Claims 29-31 find non-limiting support in the disclosure as originally filed, for

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<sup>3</sup> See Van Valer at column 11, lines 6-26.

example at page 9, line 23 to page 13, line 11 of the specification; Claims 20 and 21; and Figure 2. Applicants note that new Claims 29-31 are dependent on independent Claims 23 and 27, and are believed to be patentable for at least the reasons discussed above.

New Claims 29 and 30 are further believed to be patentable as Van Valer does not disclose that “graphic data are generated by a graphic tool, which is part of an applet, having a drawing functionality.” Van Valer describes that when a user wishes to select the specific elements used to generate the table of contents image, software assists in the selection by automatically displaying album titles and thumbnail images that are relevant to a particular online photo album that the user wants to archive onto a disc.<sup>4</sup> Thus, in Van Valer, the design of the table of contents label is predetermined and may not be designed or modified by the user. Further, in Van Valer, it is not possible for a user to design a real graphic to be printed on the CD. In contrast, in Applicants’ Claims 29 and 30, graphic data is generated by a graphic tool having drawing functionality. That is, a user can create graphic data from scratch using the graphic tool.

New Claim 31 recites that “the determining comprises downloading an applet from the network capable server, and executing the applet by a web browser to allow the user to select the disk category and disk type in order to generate the graphic data for the disk label,” and is believed to be patentable for the reasons discussed above with respect to Claim 21.

Accordingly, Applicants respectfully submit that new dependent Claims 29-31 are patentable.

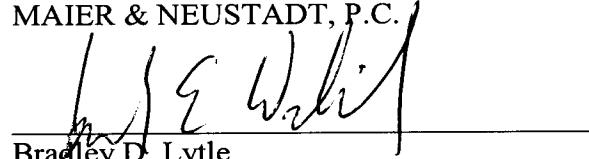
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<sup>4</sup> See Van Valer at column 13, lines 3-12.

Consequently, in view of the present amendment, and in light of the above discussion, the pending claims as presented herewith are believed to be in condition for formal allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'B D Lytle', is written over a horizontal line.

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